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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/658,141  | 09/08/2000  | Yoshimasa Utsumi     | 450100-02701        | 3562             |
| 20999   | 7590        | 05/05/2005           | EXAMINER            |                  |
| FROMMER LAWRENCE & HAUG<br>745 FIFTH AVENUE- 10TH FL.<br>NEW YORK, NY 10151 |             |                      | VENT, JAMIE J       |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2616                |                  |

DATE MAILED: 05/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/658,141

Applicant(s)

UTSUMI, YOSHIMASA

Examiner

Jamie Vent

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 22, 2005 has been entered.

The following is the response to arguments for Claims 1-24 based on applicant's amendment dated February 22, 2005.

On pages 8-9 applicant argues that Yamauchi et al in view of Watanabe et al fails to teach, suggest, or disclose the limitation of: "judging means for judging whether the inserted memory is copyright-protected when a normal response is obtained within a predetermined period of time of authorization process " as disclosed in independent Claim 1. Yamauchi et al shows in Figure 105a the judgment of the type of source, first or second memory card, and thereby determines what destination, first or second memory card, the contents will be recorded in a predetermined set time. It is anticipated that this method can be done in two ways depending on the number of insertion holes. If one slot is present the data would be read from the memory card in the insertion hole and the data would be sent to hard drive. Depending on the results from the judgment factor user would enter another memory card, first or second, for recording. If two slots were present the data will simply be judged and transferred, during a predetermined time, from the respected memory cards as depicted in the display V25 of Figure 105a. Furthermore, Yamauchi et al is silent on the data being recorded; however, Watanabe et al discloses a method of memory card management wherein the data being recorded is copyright protected or unprotected as disclosed in Column 9 Lines 38-47 which states "...bit D4 a

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copy protect but indicates that the IC memory card is prohibited from being copied, and the bit D3 a copied state bit indicates that the data of the associated packet has been copied."

Therefore, by combining the data being recorded onto the memory cards of the Watanabe et al system and incorporate the data into the Yamauchi et al system would provide a recording and judging means for copyrighted and un-copyrighted material that is recorded on a memory card and thereby meeting the limitations. While applicant's points are understood the examiner cannot agree and the rejection is maintained.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamauchi et al (US 6,020,982) in view of Watanabe et al (US 5,590,306).

**[claims 1 & 10]**

In regard to claims 1 and 10, Yamauchi et al discloses a terminal apparatus and a recording apparatus with corresponding method comprising:

- Insertion hole into which is inserted a first memory card and a second memory, wherein the memory cards being substantially the same shape (Figure 60 shows the one insertion hole for a memory card as claimed while Figure 62 shows insertion holes for two memory cards like that shown in applicant's Figure 1. The memory cards can be recorded with copyright or un-copyrighted material depending on the data input into the system. Thereby the limitations are

anticipated by the reference. Furthermore, Figure 61 shows two memory cards both being the same shape);

- Judging means for judging whether the inserted memory card (Figure 39a step s3 shows the process of determining which memory card has been entered into the insertion hole);
- Recording means which, if said judging means judges that said first memory card is inserted prior to recording contents then said recording means temporarily records contents to said first memory card for a predetermined period of time (Figure 105a shows the judgment of the type of source, first or second memory card, and thereby determines what destination, first or second memory card, should the contents be recorded. It is anticipated that this method can be done in two ways depending on the number of insertion holes. If one slot is present the data would be read from the memory card in the insertion hole and the data would be sent to hard drive. Depending on the results from the judgment factor user would enter another memory card, first or second, for recording. If two slots were present the data will simply be judged and transferred, during a predetermined time, from the respected memory cards as depicted in the display V25 of Figure 105a);
- Controlling means if the first or second memory card is inserted into the insertion hole after the recording means has recorded the contents to the first or second memory card and said controlling means automatically transfers the recorded contents from the first or second memory card to the inserted first or second memory card (Figure 105a shows the controlling of the storing and image copies of the two memory cards as well as recording source and contents as further

explained in Column 55 Lines 50-65. Furthermore, it is seen in Figure 106 that the system records the contents of the a memory card automatically transfers the recorded contents to the contents of the other memory card and described in Column 56 Lines 29-39);

however, lacks the recording contents to be copyright-protected and copyright unprotected. Watanabe et al discloses a system with copyright-protected (read) and copyright-unprotected (write) as seen in Figure 5. The write, read and copy protected of the data cards are set to indicate if the data is protected or unprotected as further discussed in Column 9 Lines 39-47 and thereby allows for the system to judge if the card is copy protected or copy unprotected. By using an apparatus and corresponding method for copyrighting protected and unprotected data contents allows for a clear indication of what type of data contents is present on that particular card.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to use the image data processing of the digitally reproducing an optical data image, as disclosed by Yamauchi et al, and incorporate the recording contents to be copyright-protected and/or copyright-unprotected on both first and second memory cards, as disclosed by Watanabe et al, in order to protect the data contents within the memory cards or allow the appropriate data to be recorded onto the memory cards of the system.

**[claims 2]**

In regard to Claim 2, Yamauchi et al, discloses a terminal apparatus wherein the insertion hole has a plurality of slots into which a plurality of memory cards may be inserted concurrently (Figure 62 elements 614 and 615 are slots for memory cards).

**[claims 3]**

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In regard to Claim 3, Yamauchi et al, discloses a terminal apparatus wherein the insertion hole has a single slot which accommodates only one memory card and into which said first memory card is inserted to have recorded contents before the first or second memory card is removed from said insertion hole and replaced by the first or second memory card inserted (Figure 60 element 533 shows the single slot as well as the one memory card while Figure 105a shows the contents of the memory cards and the contents to be recorded as well as the designations (memory card one or two).

**[claims 4]**

In regard to Claim 4, Yamauchi et al, discloses an apparatus for recording contents such as music, videos, and games (Figure 74 shows the recording contents can be music, videos, and games through the input of elements 602, 814, 817, and 818 and recording onto the memory card 400 or hard disk 819 or other mediums).

**[claims 5 & 6]**

In regard to Claims 5 and 6, Yamauchi et al discloses an apparatus for recording contents while Watanabe et al discloses an copyright protection contents apparatus and corresponding method; however, fails to disclose that the copyright-unprotected contents are constituted by a copyright free software that is made up of privately produced contents.

The examiner takes official notice that it is well known in the art that to produce copyrighted material a software application would be used and thereby the software can be produced privately and independent from the apparatus. It would have been obvious to one skilled in the art at the time of the invention to disclose that copyright free software is used when producing a copyright protected or unprotected contents.

**[claims 7 & 11]**

In regard to Claims 7 and 11 Yamauchi et al discloses a terminal apparatus wherein the controlling means transfers the recorded contents from said first or second memory card to first or second memory card inserted in an insertion hole, before erasing the contents from the first or second memory card (Figure 115 shows the varying modes that can occur to the memory cards including copy, exchange, and/or deletion. The process is further described in relation to the memory cards in Column 58 Lines 35+).

**[claims 8 & 12]**

In regard to Claims 8 and 12, Yamauchi et al discloses a terminal apparatus comprising a comparing:

- means for comparing a recordable capacity of the first or second memory card inserted in the insertion hole with the capacity of the recorded contents of first or second memory (Figure 76 card type connector 504 confirms various pieces of information added to the data obtained from the memory card 400 or card type connector 504 thereby checking the recording capacity of each card);
- controlling means permits the transfer of the recorded contents between the memory cards if said recordable capacity of the first or second memory card is judged to be greater than the capacity of the recorded contents in the first and second memory card upon comparison by comparing the contents (Figure 76 card selection control unit 629a controls and permits the transfer of data from the first and second memory card depending on the remaining capacity of the cards);
- controlling means inhibiting the transfer if the recordable capacity of the second memory card is judged to be less than the capacity of the recorded contents of the first or second memory card (Figure 76 card data input/output control unit



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629c controls the transfer of data depending on the recording capacity set by the card type connector 504).

**[claim 9]**

In regard to claim 9, Yamauchi et al discloses a terminal apparatus comprising:

- microphone (Figure 1 camera incorporates a microphone)
- A/D converting (Figure 1 element 608);
- Compression processing means for subjecting to a predetermined compression process and digital audio signal following the conversion by the A/D (Figure 1 element 609);
- Compressed digital and audio signal from the compression processing means is recorded by the first or second memory card (Figure 1 shows the recording onto the data bus for later transfer and recording onto the memory cards).

***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Mizuta (US 5,131,091);
- Clark (US 6,343,280).

***Contact Fax Information***

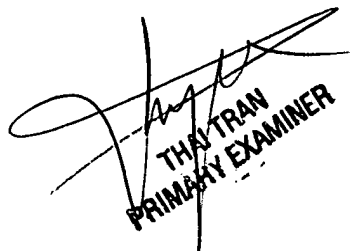
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamie Vent whose telephone number is 571-272-7384. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 571-272-7375. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jamie Vent



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PRIMARY EXAMINER